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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/232,290 01/15/99 PLUCKTHUN

A MORPHO/7

HM12/1006

JAMES P HALEY JR  
FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
NEW YORK NY 10020-1104

EXAMINER

DECLoux, A

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

10/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/232,290

Applicant(s)

Pluckthun, A et al.

Examiner

Amy DeCloux

Group Art Unit  
1644



☒ Responsive to communication(s) filed on 1-15-99 and 4-5-99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-36 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Notice to Comply with Sequence Disclosure Requirements

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### DETAILED ACTION

1. Applicant's amendments, filed 1-15-99 and 4-5-99 (Paper Nos. 4 and 6, respectively), are acknowledged. The applicant is reminded that the amendment must point to a basis in the specification so as not to add any new matter.

Claims 1-4, 6, 7, 13, 26, 28-32 and 34 have been amended.

Claims 35 and 36 have been added.

Claims 1- 36 are pending.

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide And/Or Amino Acid Sequence Disclosures.

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-27, drawn to nucleic acids encoding an IgSF domain or fragment, or fusion protein comprising an IgSF domain or fragment, vectors, transformants and expression thereof, classified in Class 536, subclasses 23.4, 23.5, 23.53, Class 435, subclasses 69.1, 69.7, 252.3, 320.1,

II. Claims 28-30, 35, and 36, drawn to an IgSF domain or fragment, or fusion protein comprising an IgSF domain or fragment encoded by the DNA of Invention I, classified in Class 424, subclasses 184.1 and 192.1,

III. Claim 31, drawn to a method for deriving a DNA sequence encoding an IgSF domain or fragment, or fusion protein comprising an IgSF domain or fragment, encompassed by Invention I, classified in Class 435, subclasses 6, or

IV. Claims 32-34, drawn to a method of making/producing an IgSF domain or fragment or fusion protein comprising an IgSF domain or fragment encompassed by Invention II, classified in Class 435, subclasses 69.1 and 69.7.

4. Inventions I and II are different products. The proteins of Invention II are unique from the DNA, vector and host of Invention I. Nucleic acids and proteins are distinct because their structures and modes of action are different, which require non-coextensive searches. Therefore Inventions I and II are patentably distinct. The DNA, vector and host as well as the method of making a protein using DNA will be examined together because the host and vector are expressly used for the purpose of protein expression.

5. Inventions I and IV are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the instant case, the DNA of Invention I can be used for the production of antibody using DNA vaccines or hybridization assays as well as for the production of an IgSF domain or fragment or fusion protein, as encompassed by Invention IV. Therefore, Inventions I and IV are patentably distinct.

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Art Unit 1644

6. Inventions III and IV are different methods. Different ingredients, process steps and endpoints are clearly required for the analytical method of deriving a DNA sequence encoding an IgSF domain or fragment, or fusion protein (Invention III) and the method of making or producing an IgSF domain or fragment, or fusion protein (Invention IV), the endpoint of Invention III being a DNA molecule, and the endpoint of Invention IV being a protein. Therefore, Inventions III and IV are patentably distinct.
7. Because inventions I-IV are distinct for the reasons given above, and they have acquired a separate status in the art because the searches are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.
8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.
9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. a message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.
11. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Amy DeCloux, Ph.D.  
Patent Examiner  
Group 1644  
Technology Center 1600  
September 21, 1999

PHILLIP GAMBEL  
PATENT EXAMINER  
~~GROUP 1644~~

tech center 1600  
PHILLIP GAMBEL  
9/27/99